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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,110	06/02/2005	David Hilton	5035-208US/P29836USA	1260
20802	7590	05/04/2006	EXAMINER	
SYNNESTVEDT LECHNER & WOODBRIDGE LLP			LE, NANCY LOAN T	
P O BOX 592			ART UNIT	
PRINCETON, NJ 08542-0592			PAPER NUMBER	

3621

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/537,110

Applicant(s)

HILTON, DAVID

Examiner

NANCY LOAN T. LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/537,110.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02 June 2005
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-18 have been examined.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. §119(a)-(d).

The certified copy has been filed in parent Application No. 10/537,110, filed on 02 June 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims contain alternative phraseology language "or".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 10-12 and 14 are rejected under 35 U.S.C. §102(b) as being anticipated by Thomson et al., U.S. Patent No. 5,121,945.

As per claim 1, Thomson et al. disclose a document which comprises the name of an ostensible beneficiary in human readable form (i.e., Payee's Name – col. 7 line 21, Figure 2a: item 40), together with machine readable form encoded data that can be decoded to generate a unique identifier (i.e., Payee's Bar Code A/R Account No. and Bar Code Amount – Fig. 2a: items 65, 75, col. 3 lines 53-68, col. 7 line 28), the unique identifier being a function of unique data present in a human readable form on an

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identification item carried by a true beneficiary of the document, but having no simple functional relationship to any data on the document, such that the ostensible beneficiary of a document can be authenticated by comparing the unique identifier obtained from the document with the unique data on the identification item provided by the ostensible beneficiary (i.e., the Payee's *Bar Code A/R* Account No. 65 and Bar Code Amount 75 as shown on the front side of the check in Figure 2a after being scanned/read by a bar code scanner/reader would generate a unique *human readable* Payee's A/R Account No. and Amount which can then be compared with the Payee's Name 40 and Address 41, the A/R Account No. 60, Transit/Routing No. 35, Bank Account No. 30, the Bank Name & Address 15, the Numbered Amount Due 55 and the Written Amount Due 50, etc. as shown on either the front or back side of the check in Figures 2a, 2b).

As per claims 2 and 11, Thomson et al. disclose the document of claims 1 and 10, respectively, in which the document is a cheque (check) (Abstract, col. 3 line 63, Figure 2a), and the ostensible beneficiary is the payee named on the cheque (i.e., Payee Name – col. 7 line 21, Figure 2a: item 40).

As per claims 3 and 12, Thomson et al. disclose the document of claims 1 and 10, respectively, in which the machine readable encoded data is printed onto the document as a 1 or 2D bar code or other form of graphical symbology (i.e., Bar Code – Fig. 1b: item 87; Payee's Bar Code Account No. and Amount – Fig. 2a: items 65, 75, col. 3 lines 53-68, col. 7 line 28).

As per claims 5 and 14, Thomson et al. disclose the document of claims 1 and 10, respectively, in which the document is selected from the following list of document types:

- (a) prescription for medicine;
- (b) tickets;
- (c) tickets, stamps or other indicia issued by a third party to an end-user and printed by that end-user (i.e., the check document itself {issued by a bank} as part of the integrated billing document – is used to pay a payee who is a billing/invoice company/organization, by a high-speed printer, such as a laser printer {Fig. 3} by such a payee/billing/invoice company/organization – col. 15 lines 52-63);
- (d) credit, charge or debit card.

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As per **claim 10**, Thomson et al. disclose a method of authenticating an ostensible beneficiary presenting a document, in which the document comprises the name of the ostensible beneficiary in human readable form (i.e., Payee's Name – col. 7 line 21, Figure 2a: item 40), together with machine readable encoded data that can be decoded to generate a unique identifier (i.e., Payee's Bar Code A/R Account No. and Bar Code Amount – Fig. 2a: items 65, 75, col. 3 lines 53-68, col. 7 line 28), the unique identifier also being a function of unique data present in a human readable form on an identification item carried by a true beneficiary of the document, but having no simple functional relationship to any data on the document, comprising the step of:

- comparing the unique identifier obtained from the document with the unique data on the identification item provided by the ostensible beneficiary (i.e., the Payee's *Bar Code A/R Account No. 65* and *Bar Code Amount 75* as shown on the front side of the check in Figure 2a after being scanned/read by a bar code scanner/reader would generate a unique *human readable* Payee's *A/R Account No. and Amount* which can then be compared with the Payee's Name 40 and Address 41, the A/R Account No. 60, Transit/Routing No. 35, Bank Account No. 30, the Bank Name & Address 15, the Numbered Amount Due 55 and the Written Amount Due 50, etc. as shown on either the front or back side of the check in Figures 2a, 2b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 9, 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thomson et al., U.S. Patent No. 5,121,945 as applied to claims 1 and 10, respectively, above, and in view of Warther et al., U.S. Patent No. 6,305,716 B1.

As per **claims 4 and 13**, Thomson et al. disclose a document comprising all limitations as described in claims 1 and 10 above.

Thomson et al. do not expressly disclose such a document, in which the machine-readable encoded data can be scanned by a bar code scanner.

Warther et al., however, suggest a document, in which the machine-readable encoded data can be scanned by a bar code scanner (i.e., bar code optical reader devices -- col. 5 lines 29-32) to permit reading of the machine readable representation of unique code underlying the covering by such devices.

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a document as disclosed in claims 1 and 10 by Thomson et al. to include "*in which the machine-readable encoded data can be scanned by a bar code scanner*" as suggested by Warther et al. to permit reading of the machine readable representation of unique code underlying the covering by such devices.

As per **claims 9 and 18**, Thomson et al. disclose a document comprising all limitations as described in claims 1 and 10 above.

Thomson et al. do not expressly disclose such a document, in which the machine-readable encoded data does not always appear in the same format in different documents associated with the same beneficiary.

Warther et al., however, suggest a document, in which the machine-readable encoded data does not always appear in the same format in different documents associated with the same beneficiary (Abstract: the second, third, and fourth sentences; col. 1 line 67 – col. 2 line 15, col. 11 lines 45-62) to ensure uniqueness of data in different documents, and therefore, to make it harder to re-create/reproduce data and thereby to prevent fraudulent.

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a document as disclosed in claims 1 and 10 by Thomson et al. to include "*in which the machine-readable encoded data does not always appear in the same format in different documents associated with the same beneficiary*" as suggested by Warther et al. to ensure

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uniqueness of data in different documents, and therefore, to make it harder to re-create/reproduce data and thereby to prevent fraudulent.

Claims 6 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thomson et al., U.S. Patent No. 5,121,945 as applied to claims 1 and 10, respectively, above, and in view of Shatz, U.S. Patent No. 5,341,428.

As per claims 6 and 15, Thomson et al. disclose a document comprising all limitations as described in claims 1 and 10 above.

Thomson et al. do not expressly disclose such a document, in which the identification item is selected from the following test of document types:

- (a) identification card or other form of document
- (b) passport
- (c) drivers license
- (d) document printed with biometric data
- (e) iris
- (f) finger.

Shatz, however, suggests a document, in which the identification item is selected from the following test of document types:

- (a) identification card or other form of document
- (b) passport
- (c) drivers license
- (d) document printed with biometric data
- (e) iris (col. 3 lines 37-41)
- (f) finger

to validate/verify the relationship between the document/check, etc. and the individual presenting it as well as the eligibility of the individual to receive funds (col. 3 lines 32-34).

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a document as disclosed in claim 1 by Thomson et al. to include “in

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which the identification item is selected from the following test of iris" as suggested by Schatz to validate/verify the relationship between the document/check, etc. and the individual presenting it as well as the eligibility of the individual to receive funds (col. 3 lines 32-34).

Claims 7 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thomson et al., U.S. Patent No. 5,121,945 as applied to claims 1 and 10, respectively, above, and in view of Ray et al., U.S. Patent No. 5,673,320.

As per **claims 7 and 16**, Thomson et al. disclose a document comprising all limitations as described in claims 1 and 10 above.

Thomson et al. do not expressly disclose such a document, in which the identification item comprises a photographic image of the true beneficiary.

Ray et al., however suggest a document in which the identification item comprises a photographic image of the true beneficiary (i.e., a picture of the document holder – col. 6 line 19) as a quick visual means to verify the validity of the document and its bearer.

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a document as disclosed in claim 1 by Thomson et al. to include "*in which the identification item comprises a photographic image of the true beneficiary*" as suggested by Ray et al. to quickly & visually verify the validity of the document and its bearer.

Claims 8 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thomson et al., U.S. Patent No. 5,121,945 as applied to claims 1 and 10, respectively, above, and in view of Greene et al., U.S. Patent Application Publication No. 2003/0131239 A1.

As per **claims 8 and 17**, Thomson et al. disclose a document comprising all limitations as described in claims 1 and 10 above.

Thomson et al. do not expressly disclose such a document, in which the machine-readable encoded data is related to the unique data by a one-way hash function.

Greene et al., however, suggests a document, in which the machine-readable encoded data is related to the unique data by a one-way hash function (para. [0035, 0042]) that generates a hash value

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that is known to be irreversible, from which to keep the unique data from being guessed or re-generated/re-created by a criminal, and therefore, to prevent fraudulent.

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a document as disclosed in claims 1 and 10 by Thomson et al. to include "*in which the machine-readable encoded data is related to the unique data by a one-way hash function*" as suggested by Greene et al. to keep the unique data from being guessed or re-generated/re-created from an irreversible hash value generated by a one-way hash function by a criminal, and therefore, to prevent fraudulent.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday-Thursday, 7am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES P. TRAMMELL can be reached on **(571) 272-6712**. ***For official/regular communication***, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**. ***For informal/draft communication***, the fax number is **(571) 273-7066 (rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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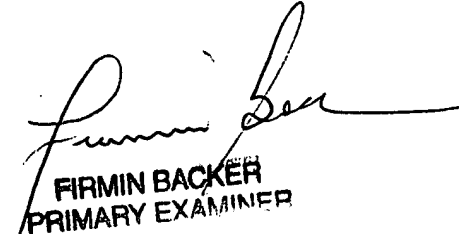
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17 April 2006



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